

R E M A R K S

- Claims 1-96 are pending in the present application.
- Claims 1, 29, 37-43, 54-96 are independent.
- Claim 97, a dependent claim, has been added herein.
- Claim 42, an independent claim, and claim 24, a dependent claim, has been cancelled herein, without prejudice or disclaimer.
- Since this Amendment and Response is being submitted in response to a Final Office Action, Applicants have filed a Request for Continued Examination herewith, to ensure consideration of the amendments and remarks.

1. Section 101 Rejections

Claims 1 – 68 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. “These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or better clarify that the method is utilizing a medium or apparatus, etc. within the technological arts.” Current Office Action, page 2.

Although Applicants maintain, from the response to the Previous Office Action (i.e., the Office Action mailed August 19, 2003), that the §101 rejection is improper for failing to be based on any statutory, regulatory, or court opinion requirement, Applicants have amended claims 1, 29, 37 – 41, 43, and 54 – 68 (each of the independent claims in the set of claims rejected under §101). This amendment has been made solely to expedite the prosecution of the present Application. Applicants reserve the right to pursue the subject matter of claims 1 – 68 as pending before the amendments made herein in a continuing application. Claims 1, 29, 37 – 41, 43 and 54 – 68 have been amended to recite that one of the steps of the method is performed *via a computing device*. Accordingly, Applicants respectfully submit that the §101 rejection has been overcome.

2. Section 103 Rejections

Claims 1 – 15, 17 – 21, 24 – 47 and 49 – 96 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,112,186 to Bergh (“Bergh” herein) in view of U.S. Patent No. 5,970,469 to Scroggie (“Scroggie” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Neither Bergh or Scroggie, alone or in combination, disclose the following claim features:

- selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated
 - the first product and the second product, and
 - a willingness to purchase any one of the first product and the second product

Similarly, neither Bergh or Scroggie discloses receiving from a customer an indication of (i) two services or retailers, and (ii) a willingness to purchase any one of the two services or from either of the two retailers, and then having the system select, for the customer, one of the two services or retailers. Each of the pending claims has been amended herein to claim one of these particular embodiments of the present invention.

In Bergh, a customer may rate specific items but then the system does not recommend those rated items to the customer. Rather, the Bergh system selects different items, ones not indicated by the customer, to recommend to the customer. Further, Bergh does not disclose receiving from a customer a willingness to purchase any item, much less an item to be selected for the customer.

In Scroggie, a customer himself may select particular items to purchase either by selecting the items individually or by selecting a recipe and thus selecting each of the items included in the recipe. In other words, one item is not selected for the customer from two items indicated by the customer, much less from two items for which the customer has indicated a willingness to purchase.

Claims 65 – 68 recite the above steps from the customer’s perspective. Since neither Bergh or Scroggie discloses the above features from the system’s perspective, it follows that neither Bergh or Scroggie discloses the features from the customer’s perspective.

Allowing a system to make a selection of two products, services or retailers that the customer has indicated he is willing to purchase or purchase from has many advantages not recognized by the prior art, as explained in the specification (e.g., page 9, lines 7 through 31). For example, the claimed methods “enables manufacturers or other suppliers if premium brands of products and services to sell products and services to brand indifferent customers at reduced prices without losing revenue on sales of products and services to brand-loyal customers and without brand-dilution.” Specification, page 9, lines 7 – 11.

The following example illustrates the above advantage. Assume it doesn’t matter to one customer whether his toothpaste is Brand A or Brand B. This brand indifferent customer may utilize the claimed systems and methods to indicate a willingness to purchase any one of a tube of toothpaste of Brand A and a tube of toothpaste of Brand B. The manufacturer of Brand A, for example, may be willing to offer a significant discount to such a brand indifferent customer in the hopes of converting the customer to a Brand A loyal customer. Another customer, on the other hand, may only be willing to purchase Brand A toothpaste. Such a customer may not be willing to let the claimed system select a tube of toothpaste for the customer from either Brand A or Brand B, due to a concern that Brand B would be selected. Thus, the claimed systems and methods allow manufacturers and other suppliers to differentiate among such brand loyal and brand indifferent customers (since only Brand indifferent customers may be willing to use the claimed systems and methods). Thus, the manufacturer of Brand A may better target funds for discounts. Rather than simply offering a discount on Brand A toothpaste (which would provide the discount to both the brand indifferent customer and the brand loyal customer who would have purchased Brand A even if there was no discount on it), the manufacturer may only offer discounts to brand indifferent customers by identifying those customers via the methods and systems of the present invention.

Claims **16, 22, 23 and 48** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bergh in view of Scroggie in further view of U.S. Patent No. 5,537,314 to Kanter ("Kanter" herein). Applicants respectfully traverse this rejection (which has been maintained from the Previous Office Action) for the same reasons discussed in the Response to the Previous Office Action. However, since each of claims **16, 22, 23 and 48** is dependent from an independent claim that includes the features discussed above, Applicants respectfully submit that claims **16, 22, 23 and 48** are patentable at least for the same reasons discussed above.

3. New Claim 97

Claim **97** has been added to explicitly claim an embodiment where a customer, along with indicating a first product and a second product, indicates a binding commitment to purchase a one of the first product and the second product that is selected for the customer.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7337041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **one-month** extension of time with which to respond to the Office Action. If an additional extension of time is required in addition to that requested, please grant a petition for that extension of time which is required to make this Response timely.

Please charge as follows:

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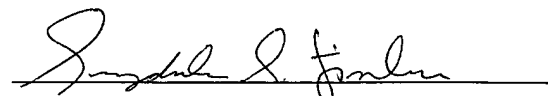
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Charge any additional fees or credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.

Respectfully submitted,

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Date


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